

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

040130-050010US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 26, 2006

Signature _____

Typed or printed name Connie Larson

Application Number

10/602,416

Filed

June 23, 2003

First Named Inventor

Scott Seamans

Art Unit

3728

Examiner

Jila M. Mohandesi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 38,464

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

Signature

Darin J. Gibby

Typed or printed name

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January 26, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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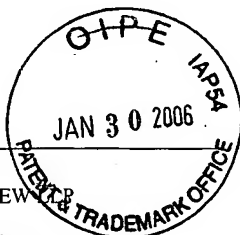
On

Jan 26, 2006

TOWNSEND and TOWNSEND and CREW

By:

Connie Karm



**APPLICANTS' ARGUMENTS FOR
PRE-APPEAL BRIEF REVIEW –
EXAMINING GROUP 3728**

PATENT

Attorney Docket No.: 040130-050010US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Scott Seamans

Application No.: 10/602,416

Filed: June 23, 2003

For: FOOTWEAR PIECES AND
METHODS FOR MANUFACTURING
SUCH

Customer No.: 20350

Confirmation No. 9598

Examiner: Jila M. Mohandesi

Technology Center/Art Unit: 3728

**APPLICANTS' ARGUMENTS FOR PRE-
APPEAL BRIEF REVIEW - EXAMINING
GROUP 3728-**

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This statement is submitted in support of the Pre-Appeal Brief Request for Review, which is submitted herewith, along with a Notice of Appeal. The applicant respectfully asserts that the rejections set forth in the Office Action mailed January 9, 2006 are improper for the following reasons:

Arguments begin on page 2 of this paper.

ARGUMENTS

Rejection Over Aguerre, Seidel, Admitted Prior Art and Albiniano

Claims 1, 9, 12-16, 18-27 and 40-42 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the cited portions of U.S. Patent No. 6,237,249 to Aguerre, *et al.* (hereinafter "Aguerre") in view of U.S. Patent No. 4,476,600 to Seidel, *et al.* (hereinafter "Seidel"), the alleged admitted prior art page 11 of the instant specification and U.S. Patent No. 2,897,566 to Albiniano (hereinafter "Albiniano"). This rejection is respectfully traversed for at least the reasons which follow.

The presently pending claims relate to footwear comprising a base section and a strap section, both respectively formed as a part molded from lofted foam material. The strap section is attached to the base section such that the strap pivots relative to the base section with a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter to thereby maintain the strap section fixed relative to the base section.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicants' disclosure. See M.P.E.P. §§2143.01 and 2143.03.

The present rejection fails to present a *prima facie* case of obviousness for at least two reasons. First, as mentioned above, the present claims require that the strap section is formed as a second continuous piece of a lofted foam material. None of the cited art teaches this limitation. More specifically, Seidel fails to teach any strap and neither Aguerre nor Albiniano teach or suggest a strap that is made out of such a material. Further, counsel forcefully disagrees that the present application admits that making such a strap of a lofted foam material is prior art. Although the application does describe an existing type of lofted foam material that is useful in

connection with the present invention, the specification never admits that this material was known in making a heel strap as claimed.

It appears that the only assertion in the office action that the prior art teaches the limitation of a strap section that is constructed of a lofted foam material is the following statement: "In this case, to make the upper and sole of Aguerre '249 from a piece of expanded foam material and the strap from expanded foam material as taught by Seidel '600 for easier and cheaper manufacturing of the footwear." (Page 7, line 22 through page 8, line 3). Applicant fails to understand how the above statement provides motivation for anyone skilled in the art in possession of the cited prior art to make the strap section of a lofted foam material as set forth in the claims. As cited above, none of the cited art teaches a heel strap constructed of a foam material, and the mere fact that moldable foam material exists does not provide any motivation for using such a material in a heel strap, especially in light of Seidel which does not even have a heel strap. Moreover, the examiner has provided no evidence (in support of a motivation to combine) that making a heel strap of such a material would be "easier and cheaper." For instance, this assertion provides no relative comparison of how it would be "easier and cheaper", i.e., easier and cheaper relative to what other process? Even if another process were set forth in the office action, there are no facts supporting how making a heel strap of a lofted foam material would be "easier and cheaper", if that could even be considered as a motivation at all.

Because the cited art fails to teach or suggest an important limitation of the rejected claims, claims 1, 9, 12-16, 18-27 and 40-42 are distinguishable for at least this reason.

Secondly, the claims of the present invention also require a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter which maintains the strap section fixed relative to the base section. The amount of friction generated is dictated in part because the two materials which contact each other (from the shoe body and the strap) are both constructed of a lofted foam. This allows the strap to remain in a secure location while also being relatively easy to pivot when desired.

Contrary to the present claims, Aguerre discloses a "slide-type sandal, having an elastic and flexible rear heel strap 102." Col. 4, lines 28-29. The rear heel strap disclosed by

Aguerre is further described as being capable of being “freely rotated” between a first and second position. *See, e.g.*, Col. 7, lines 49-53; Col. 9, lines 29-34, and Col. 10, lines 48-50. In fact, in several embodiments, additional washers are added to ensure free rotation about the rotation point. As explained in Aguerre, “during rotation of the rear heel strap 202 about the rivet 244, it is common for the friction between the heel strap 202, the vamp 204 and the rivet 244 to interfere with smooth rotation. In order to facilitate smoother rotation of the rear heel strap 202 about the rivet 244, one of a first pair of nylon washer separators 246 is placed on the inside of the rear heel strap 202 and one of a second pair of nylon washer separators 248 is placed on the outside of the rear heel strap 202 as shown in FIG. 12.” Col 9, lines 20-29. As such, it is submitted that Aguerre fails to teach a molded, lofted foam heel strap configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section.

While the office action attempts to cure this remedy by citing the Albiniano patent, it is well established law that the teachings of one reference may not be combined with the teaching of a second reference when there is a specific teaching away. As previously described, Aguerre specifically teaches the benefits of being freely rotated and uses washers to accomplish this. Hence, one of skill in the art would have no motivation to substitute it washers for the connectors described in Albiniano. Rather, such a combination is clearly hindsight reconstruction of the cited art, which is clearly impermissible.

Because the heel strap of Aguerre is designed to freely rotate about its connection point, and to specifically minimize friction to ensure free rotation through use of, *e.g.*, washer separators, it may not be properly combined with Albiniano.

In addition, with reference to Claim 42 and certain of the dependent claims, Aguerre fails to specifically disclose that the distance from the first attachment point to the second attachment point along the upper opening perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section, or that the distance from the first attachment point to the second attachment point along the rear sole

perimeter is approximately the same distance from the first attachment point to the second attachment point along the strap section. Further, Aguerre fails to specifically disclose that the strap section can pivot relative to the base section such that an inner portion of the strap section contacts an outer portion of the rear sole perimeter.

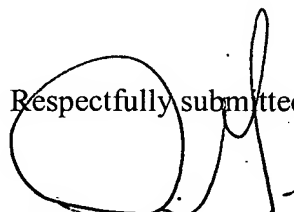
Hence, for this additional reason, a prima facie case of obviousness has not been established. Therefore, Applicants traverse the rejection of claims 1, 9, 12-16, 18-27, and 40-42, and respectfully request withdrawal of this rejection.

Rejection Over Aguerre, Seidel, Admitted Prior Art and Albiniano and Lamstein

Claims 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Aguerre, Seidel, Admitted Prior Art, Albiniano the cited portions of U.S. Patent No. Des 416,667 to Lamstein, *et al.* (hereinafter "Lamstein").

Whatever else Lamstein may disclose, it does not disclose a heel strap constructed of a lofted foam material that is configured such that a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter maintains the strap section fixed relative to the base section. As such, for at the least these reasons and those detailed above, this rejection is traversed and withdrawal of this rejection is respectfully requested.

Respectfully submitted,


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